



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/708,839

03/26/2004

Blayn W. Beenau

70655.0300

2838

20322

7590

11/21/2005

SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,839

Applicant(s)

BEENAU ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 29 August 2005.

Claim Objections

2. Claim 14 is objected to because of the following informalities:

Replace "at least one of" with -- at one of --.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/710,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is drawn towards a transponder/reader system, while the '332 Patent Application is drawn towards a smartcard

system. The Examiner recognizes that both a transponder and reader are contactless means of communicating data, and as per the prior art of Black (cited in previous Office Action) can be used interchangeably (functionally equivalent). One would have been motivated to use a smartcard/transponder based on system constraints, desired security, desired communication range, cost, etc., where such benefits of the technologies are known in the art.

For instance in claim 1 of the present claimed invention and claims 1 of the '332 Patent Application, the Applicants claim:

i) "...transponder...registering biometric information...receiving a proffered biometric sample...receiving user information...associating said proffered biometric...at least two of...account." (see claim 1), whereas in the '838 Patent Applicant the Applicants claim "...smartcard...registering biometric information...receiving a proffered biometric sample...receiving user information...associating said proffered biometric...at least two of...account." (see claim 1)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 6,925,656) in view of de Sylva (US 2005/0098621).

Re claim 1, Black teaches receiving a proffered biometric sample at a sample receiver, receiving user information at said sample receiver; associating the biometric sample with the user information to create a data packet (FIG. 5A+, 4A, and abstract). The user information stored is interpreted as a data packet that associates user information, biometric information, and transponder information as the transponder has a unique customer number/serial number that is part of the record. Though Black is silent to receiving transponder information and associating it with the user information and biometric sample as part of the data packet, the Examiner notes that each transponder has an associated unique record/serial number. Such unique identifying means serve as a well known and conventional means to identify and provide security to the system. Accordingly, it would have been obvious to one of ordinary skill in the art to receive the unique identifier and associate it with the data packet as a means to identify and verify the authenticity of the device.

Black is silent to the proffered biometric sample being associated with at least two of a charge account, a credit card account, a debit card account, a savings account, a private label account, and a loyalty point account.

The Examiner notes that it is well known and conventional that one card/transponder can have many consolidated accounts on it/access to many accounts, for convenience of the user (a consolidated card requires less cards to be carried by a user and is more convenient). Along those lines, de Sylva teaches that one biometric sample is required and that one sample is associated with different accounts based on a relationship established by the user account record (30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of de Sylva.

One would have been motivated to do this to increase convenience by only requiring one sample to maintain security but allowing a user to establish a relationship for multiple account usage (convenience).

Re claim 2, Black teaches contacting an authorized sample receiver through at least one of a computer Internet, software, hardware, third party biometric entity, kiosk, biometric registration terminal, and communication device (FIG. 1A). It is clear that during reception of the sample that the receiver is in contact with one of a computer, internet, software, hardware, biometric entity, kiosk, biometric registration terminal, and a communication device in order for the sample to be received and to facilitate the transaction.

Re claim 3, Black teaches the receiving of the sample includes at least one of processing storing, comparing, and verifying the sample as a record is created as discussed above. It would

have been obvious to one of ordinary skill in the art to process/store/compare/verify the sample as such means are conventional in the art to authenticate a sample (that it is real), and put it into a format that can be recognized, and stored for accessing and verifying a user.

Re claim 4, it has been discussed above that the proffered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information (FIG. 3).

Re claim 5, Black teaches (FIG. 1A) that the data can be stored on a host computer or on the transponder itself (col 4, lines 29+), where is interpreted as being contained in at least one of a transponder, transponder reader, sensor remote server, merchant server, and transponder-reader system. Though Black is silent to database, Black teaches that according to the desired security, information can be stored on the transponder itself or remotely. Therefore, it is well within the skill in the art to store the data packet information at one of the locations set forth in the claim, depending on the desired type of security, using a database, which is a well known and conventional means to store and organize data.

Re claim 6, though silent to registering more than one biometric samples, the Examiner notes that it would have been obvious to do so to increase security. Specifically, de Sylva teaches such limitations (paragraph [0037] +).

Re claim 7, the Examiner notes that though Black/de Sylva are silent, it would have been obvious to one of ordinary skill in the art that different samples (from different people) would be associated with different information from those others who are registered in the system.

Re claim 8, the limitations have been discussed above, where de Sylva teaches primarily and secondarily associating different information with a sample based on preferences.

Re claim 9, the limitations have been discussed above re claim 8.

Re claims 10 and 11, as discussed above, it would have been obvious to one of ordinary skill in the art to associate different samples with different information in instances where there are multiple users of the system, for unique identification.

Re claim 12, it would have been obvious to one of ordinary skill in the art to use secondary authentication to verify the sample using a secondary security procedure to verify that the sample is real. Such procedures are well known and conventional in the art for verifying that a sample is a real sample (from a living person, and examples include temperature and blood flow sensors). Such modification is an obvious expedient for security of the system.

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]).

Re claim 14, the Examiner notes that it has been taught above and in the previous Office Action that the sample is received at one of a local database, remote database, portable storage device, host system, etc. as recited in the claim.

Re claim 15, a fingerprint scan, for example has been discussed above (see Black for example).

Re claim 16, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

Re claim 17, the teachings of de Sylva/Roster et al. have been discussed above including two different accounts that are unassociated.

Response to Arguments

5. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Additional Remarks

6. The Examiner notes that PINs associated with biometrics are well known and conventional for increased security (versus just a biometric; see US 2001/0029493, 5,764,789, 2004/0084524, 2002/0174067, 2002/0062284, 2001/0018660, which show that a PIN and biometric can be used together, for additional security over just a PIN or biometric, for example). The Examiner also notes Royer et al. (US 2004/0155101) teaches the use of different biometrics with multiple accounts and Ramachandran (US 2001/0013551) and Pitroda (US 6,925,439) which teach consolidation of card accounts onto one card for convenience.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

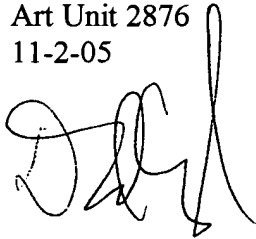
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Pare et al. (US 6,154,879), Zoka (US 6,591,249), Tanner et al. (US 2002/0073025), Robinson (US 2003/0061172), Burchette (US 2003/0106935), Shinzaki (US 2001/0017584), Macklin et al. (US 2003/0155416), Giordano et al. (US 2002/0152123), Mendelovich (US 2005/0125343), Hoshino (US 6,636,620), and Waters et al. (US 2002/0147600).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
11-2-05



KARL D. FRECH
PRIMARY EXAMINER